

REMARKS

This is a Response to the Office Action mailed June 9, 2008. By way of summary, claims 1-7 were pending in this application. In the present amendment, claim 1 has been amended, and claims 2-7 have been canceled. Claims 8 and 9 have been added. Claims 1, 8 and 9 therefore remain pending for consideration.

Rejection of Claim 1 under § 103(a)

Claim 1 was rejected under 35 U.S.C. § 103(a) as being obvious over U.S. patent application publication no. 2002/0054983, to Nishihara *et al.* ("Nishihara") in view of U.S. patent no. 6,149,999, issued to Suzuki *et al.* ("Suzuki"). This rejection is respectfully traversed because Nishihara cannot be properly combined with Suzuki to teach the elements of amended claim 1 as suggested by the Examiner.

In particular, amended claim 1 recites, *inter alia*, an optical recording medium "constituted so that data can be recorded therein and/or reproduced therefrom by a laser beam having a wavelength of 200 nm to 450 nm projected thereonto through a light incidence plane using an objective lens having a numerical aperture of 0.85 [and] a recording layer other than a recording layer farthest from the light incidence plane [comprising] a transparent heat radiation film containing one of AlN and SiC as a primary component." The amendments to claim 1 find support throughout the originally filed specification, including at p. 7, ll. 21-28, p. 10, ll. 5-9 and p. 32, ll. 11-13. The cited references cannot be combined to teach such an optical recording medium.

As acknowledged by the Examiner, Nishihara does not disclose, teach, or suggest the claimed transparent heat radiation film. Thus, the Examiner relies upon the teachings of Suzuki to teach a heat radiation film containing one of AlN and SiC. *See* Office Action, p. 3. It is respectfully submitted however that the Examiner has simply used hindsight reasoning in order to interpose the transparent heat radiation film of Suzuki between the films of the optical recording medium disclosed by Nishihara.

Nishihara and Suzuki teach recording media having different numbers of recording layers and constituted for recording using different laser beams. Nishihara teaches a

dual layer optical recording medium, wherein each recording layer comprises a plurality of different films. *See, e.g.*, Figures 1-3. Nishihara further discloses that a laser beam having a wavelength of 405 nm may be used to record data to the optical recording medium. *See, e.g.*, ¶[0154]. In contrast, Suzuki discloses a single layer optical recording medium incorporating a heat radiation film. *See, e.g.*, Figures 1-3. Moreover, the optical recording medium disclosed by Suzuki is constituted for recording using a laser beam having a wavelength of 680 nm. *See, e.g.*, col. 18, ll. 12-13, col. 20, l. 37 and col. 22, ll. 9-10.

These inherent differences between the single layer recording medium of Nishihara and the dual layer recording medium of Suzuki, and between the laser beam wavelengths disclosed by Nishihara and Suzuki would deter a person skilled in the art from making the combination suggested by the Examiner. The Examiner ignores the fact that each of the references discloses particular materials suitable for specific processes that are not intended for use with one another. Indeed, a person skilled in the art would understand that there would be significant technical challenges in attempting, for example, to apply the heat radiation film teachings of Suzuki to the dual layer recording medium of Nishihara, which might render Nishihara unsuitable for its intended purpose, *i.e.*, recording using a particular laser beam configuration. The Examiner fails to recognize and properly consider the technical problems with the asserted combination and simply applies hindsight reasoning to support the combination.

For at least the above reasons, it is respectfully submitted that the Office Action has not presented a *prima facie* case of obviousness for amended claim 1 over Nishihara and Suzuki. It is therefore respectfully submitted that independent claim 1 is allowable over the cited references.

New Claims 8 and 9

New claims 8 and 9 have been added and are believed to be fully distinguished over the art of record. Claim 8 finds support throughout the originally filed specification, including at p. 19, ll. 20-22, and claim 9 finds support throughout the originally filed specification, including at p. 32, ll. 11-13. Because independent claim 1 is allowable over the cited

references, dependent claims 8 and 9 are also allowable at least because they include the limitations of independent claim 1.

CONCLUSION

In light of the above remarks, it is respectfully submitted that pending claims 1, 8 and 9 are in condition for allowance. Any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Although changes to the claims have been made, no acquiescence or estoppel is or should be implied thereby; such amendments are made only to expedite prosecution of the present application and are without prejudice to the presentation or assertion, in the future, of claims relating to the same or similar subject matter.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,
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